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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/555,240

11/01/2005

Ikuo Nuno

0121/0057

4259

21395

7590

07/08/2008

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EXAMINER

KOZIOL, STEPHEN R

ART UNIT

PAPER NUMBER

2624

MAIL DATE

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07/08/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/555,240	<b>Applicant(s)</b> NUNO ET AL.	
	<b>Examiner</b> STEPHEN R. KOZIOL	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3, 6, 9 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 and 12 is/are allowed.
- 6) ☒ Claim(s) 3 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/01/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/21/2005; 03/22/2007</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Detailed Action

***Summary***

1. Claims 3, 6, 9 and 12 are pending in the instant application. Claims 3 and 6 are rejected under 35 USC § 101. Claims 9 and 12 are allowed.

***Information Disclosure Statement***

2. The information disclosure statements (IDS) submitted on 03/22/2007, 12/21/2005 and 03/24/2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

***Abstract***

3. The abstract of the disclosure is objected to for the following minor informalities: due to space constraints on the face of the patent, the abstract is to be between 50 and 150 words in length (see MPEP 608.01(b)). The abstract as filed 11/01/2005 is ~209 words in length. Please trim the length of the abstract to conform with MPEP 608.01(b).

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims 3 and 6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 3 and 6 define a “display program” (claim 3) and a “recording medium in which is recorded an electronic service manual display program” (claim 6).

In view of the above-cited interim guidelines, a “program” as claimed in claim 3 is *per se* non-statutory. Claim 6 does not recite a “computer-readable medium or computer-readable memory” and is thus non-statutory (i.e., “[w]hen functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” – Guidelines Annex IV, emphasis added). The scope of the presently claimed invention encompasses products that are not necessarily computer readable (i.e. any “regarding medium” as claimed encompasses non-statutory embodiments), and thus is interpreted as not able to impart any functionality of the recited program. The examiner suggests amending the claim(s) to embody the program on “computer-readable medium” or equivalent; assuming the specification does NOT define the computer readable medium as a “signal”, “carrier wave”, or “transmission medium” which are deemed non-statutory (refer to “note”

below). Any amendment to the claim should of course be commensurate with its corresponding disclosure.

Note:

“A transitory, propagating signal ... is not a ‘process, machine, manufacture, or composition of matter.’ Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter.” (In re Nuijten, 84 USPQ2d 1495 (Fed. Cir. 2007)). Should the full scope of the claim as properly read in light of the disclosure encompass non-statutory subject matter such as a “signal” the claim as a whole would be non-statutory. Should the applicant’s specification define or exemplify the computer readable medium or memory (or whatever language applicant chooses to recite a computer readable medium equivalent) as statutory tangible products such as a hard drive, ROM, RAM, etc, as well as a non-statutory entity such as a “signal,” “carrier wave,” or “transmission medium” the examiner suggests amending the claim to include the disclosed tangible computer readable storage media, while at the same time excluding the intangible transitory media such as signals, carrier waves, etc.

Merely reciting functional descriptive material as residing on a tangible medium is not sufficient. If the scope of the claimed medium covers media other than “computer readable” media (e.g., “a tangible media,” a “machine-readable media,” etc.), the claim remains non-statutory. The full scope of the claimed media (regardless of what words applicant chooses) should not fall outside that of a computer readable medium.

One possible way to overcome the present § 101 rejection of claim 3 may be to amend the preamble of claim 3 to recite: “A computer-readable recording medium encoded with an An electronic service manual display program...” or the like.

One possible way to overcome the present § 101 rejection of claim 6 may be to amend the preamble of claim 6 to recite: “A computer-readable recording medium on which is recorded an electronic service manual display program...” or the like.

***Allowable Subject Matter***

6. Claims 9 and 12 are allowed.
7. The following is a statement of examiner’s reasons for allowance:

Each of independent claims 9 and 12 recite: “establishing in advance (and means for establishing), for each of said parts published on said parts table page, parts table page information that includes part identification information corresponding to said part and drawing identification information corresponding to said drawing that shows said part as a graphics primitive, searching for said parts table page information that includes the same part identification information as designated for said graphics primitive selected in said drawing, obtaining said drawing identification information from said parts table page information that has been found, and enhancing and displaying, in said parts table page display area, a part corresponding to said graphics primitive that is selected.”

The prior art of record fails to fairly teach or suggest at least the above “establishing in advance...” limitation in concert with the remaining limitations of each of claims 9 and 12. The closest art of record is described below:

- Dunn, U.S. Patent No. 5,884,315, Dunn describes embodiments for handling technical data that organize and link information in a computer format that is readily accessible and easily useable. Dunn provides a mechanism to arrange and store technical information from many different sources, regarding many different subjects, in one data set. The data set preferably includes a plurality of diagrams that each contain a plurality of components, identifying information that identifies each component and descriptive information that describes the components. The information is linked together so that the various distinct aspects thereof are readily accessed, as selected, by a user.
- Watson et al. U.S. Application Publication 2003/0187751, Watson discloses electronically available interactive reference materials that can preferably be accessed by using a network, such as the World Wide Web or Internet, to eliminate the need to create and transport paper. There are further described systems, methods, and means for generating, storing, and providing to a user these interactive reference materials. Watson also discloses, systems, methods, and means for generating, storing, and providing to a user interactive electronic systems for use with the interactive reference materials.
- McCloskey et al. U.S. Application Publication 2002/0026385, McCloskey discloses a method that can be used to select a part from a computer-aided design (CAD) display on a client device, and to generate an electronic purchase order with a server through interaction of the client device and server over a network. The CAD display can be generated by the client device with a browser that has a

CAD display plug-in module to permit display of a CAD drawing. The CAD drawing can display part(s) associated with reference(s), and part data accessible to the server can be stored in association with such reference(s). Upon the user's selection of a part having a reference, the client device transmits this reference to the server via the network.



*Contact*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Koziol whose telephone number is (571) 270-1844. The examiner can normally be reached on Monday - Friday 9:00 - 5:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samir Ahmed can be reached at (571) 272-7413 . Customer Service can be reached at (571) 272-2600. The fax number for the organization where this application or proceeding is assigned is (571) 273-7332.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/srk/  
06/27/2008

/Samir A. Ahmed/

Supervisory Patent Examiner, Art Unit 2624